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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,861	07/16/2002	Werner Scheler	2267.547US03	6730

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EXAMINER

ESTREMSKY, GARY WAYNE

ART UNIT PAPER NUMBER

3677

DATE MAILED: 09/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/020,861

Applicant(s)

Scheler, et al.

Examiner

Estremsky

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-4 is/are allowed.
- 6) ☒ Claim(s) 5-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☒ Certified copies of the priority documents have been received in Application No. 08/649,263.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Priority

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119 (a)-(d). The certified copy has been filed in parent Application No. 08/649,263, filed on May 17, 1996, now U.S. Pat. No. 6,000,732.

Claim Objections

2. Claim 18 is objected to because of the following informalities:
 - a. Recitation of "said container" in the preamble should be replaced with --a container--.Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 5, 6, 9-11, 16, 18, and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 4,995,430 to Bonora.

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Bonora '430 teaches Applicant's claim limitations including : a "container" - including 20,26,28, a "container door" - including 32, "locking elements" - 11, "coupler" - 142, "curved path" - although the written description of the device of the reference indicates that the motion is substantially in first and second directions, one of ordinary skill in the art should recognize that the geometry of the latch operating components inherently result in the locking elements penetrating the recesses in a 'curved path'. The limitation regarding 'curved path' cannot be given weight in accordance with 35 USC 112, 6th paragraph. See MPEP 2181-2185. It is the examiner's position that the product now claimed does not clearly define any structure of the claimed product that can be relied upon to patentably define from structure of well known products of the prior art. See MPEP 2114. Claims in a pending application should be given their broadest reasonable interpretation. In re Pearson, 181 USPQ 641 (CCPA 1974).

As regards claim 10, although the structure illustrated by Applicant as corresponding with "displacing element" is physically different from parts 136 of the reference, the limitation defining the scope of this element and what Applicant seeks exclusive rights to, has not patentably defined from that structure of the prior art. Amendment to better describe the structure of the claimed "displacing elements" is suggested.

As regards claim 18, it is suggested that "rotatably mounted to one of the door walls" be amended to more specifically require that the coupler is rotatably mounted --directly-- to the door where present limitation is broad enough to be read on the arrangement of the reference.

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As regards claim 19, reference to Fig's 6 and 7 indicate that a line drawn through the center mounting portion of the disc and parts 70 pass through and beyond a horizontal axis or the effective center axis of part 109 to achieve a "beyond dead center position for fixing the locking elements in a position".

Reissue Applications

5. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: multiple errors are described generically and does not specifically describe how the errors are corrected by the amendment. It is suggested that a new oath/declaration be provided that individually lists each error in the patent and describes how each error is corrected by the amendment.

6. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

7. The non-Final Office Action (Paper No. 13) rejected claims under 35 USC 102(b) in view of U.S.P.N. 3,421,471 to Richter, including examiner's statement that claimed container door's "spaced walls" did not patentably define from the perpendicularly-arranged walls of the reference's container door and otherwise indicating claim limitations being anticipated by the prior

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art. In response to that rejection, the independent claim 9 was amended to include terminology of “and parallel” to further define the container door’s walls’ arrangement:

“a container door fitted in said container and comprising two walls, spaced apart from and parallel to each other”.

Applicants’ arguments filed with that amendment specifically indicate that Applicant relies on the new limitation in order to patentably define from the prior art : see page 4 of Applicant’s response (Paper No. 15) filed June 25, 1999.

The claim was additionally amended at that time to specifically require that the claimed means for locking and unlocking the claimed container door was located between the two “parallel” walls:

“means for locking and unlocking said container door comprising locking elements provided within said container door between said two parallel walls and being displaceable into a moved-in position and into a moved-out end position and, when moving out, penetrates into said recesses within the container walls”.

Applicants’ arguments filed with that amendment specifically indicate that Applicant relies on the new limitation in order to patentably define from the prior art : see page 4 of Applicant’s response (Paper No. 15) filed June 25, 1999.

The claim was additionally amended at that time to specifically require specific structural arrangement of claimed locking elements, plates, rotatable disk, and motor:

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“every locking element being in the form of a projection from a plate which is directed parallel to the outwardly directed wall of said container door, wherein all plates share a common drive in form of a rotatable disk driven by a motor and acting in the locking and unlocking direction for connecting rods provided for displacing the plates, the plates being fixed in the moved-in end position and in the moved-out end position by said connecting rods”.

Applicants' arguments filed with that amendment specifically indicate that Applicant relies on the new limitation in order to patentably define from the prior art : see page 4-5 of Applicant's response (Paper No. 15) filed June 25, 1999.

The claim was additionally amended at that time to specifically require other structural features of the “means for providing a curved path” including particulars of that claimed element including its arrangement as regards each of the plurality of plate structures and couplers:

“said means for providing for providing a curved path further comprising structure to maintain and move every [locking element] plate parallel to an outwardly directed wall of said two parallel walls of the container door [and includes] by means of couplers, said couplers for every plate being [connected thereto which are] parallel to each other and [which are] rotatably [supported at the locking element] connected too said plate and also to said outwardly directed wall so that, as a result of the couplers, there is a predetermined distance between [the locking element] every plate and said outwardly directed wall in the

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moved-in state, which distance decreases during the outward movement until the locking element comes into contact with a contact surface in the recess against which the locking element is pressed in its moved-out end position”.

Applicants' arguments filed with that amendment specifically indicate that Applicant relies on the new limitation in order to patentably define from the prior art : see page 5 of Applicant's response (Paper No. 15) filed June 25, 1999.

Page 6 of Applicant's arguments filed with that amendment (Paper No. 15) of June 25, 1999, indicates that Applicant also relies on the above amendments and each of the specific arguments to overcome the other prior art rejections including rejection under 35 USC 103 in view of Richter '471 and additionally Richter '471 in view of U.S.P.N. 1,929,341 to Wegner. As applied against the 35 USC 102 rejections and again against the 35 USC 103 rejections, the arguments relating allowability to each amendment are specifically stated in Applicant's Remarks.

Consequently, the claim(s) was allowed including statement by the examiner that it was the combination of all claim limitations that could not be re-constructed for purpose of prior art rejection less improper use of hindsight, essentially in agreement with Applicant's arguments and conclusion as to teachings of the prior art and allowability of the claim(s) at hand.

Inasmuch as the above-indicated limitations are a result of amendment specifically directed at overcome prior art rejections, particularly as indicated by Applicant's arguments relating the

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subject matter of the amendments to the allowability of the invention, that subject matter has been surrendered.

Claims 5-19 do not include the above limitations and are in effect, broadened in that respect and do not include the subject matter which was surrendered in the original application in order to obtain the Patent. However, a reissue will not be granted to "recapture" claimed subject matter which was surrendered in an application to obtain the original patent. *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984); *In re Wadlinger*, 496 F.2d 1200, 181 USPQ 826 (CCPA 1969); *In re Willingham*, 282 F.2d 353, 127 USPQ 211 (CCPA 1960).

Only claims including surrendered subject matter are proper for reissue.

8. Claims 5-19 are rejected under 35 U.S.C. 251 as being improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application.

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Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Allowable Subject Matter

9. Claims 1-5 are allowed.
10. Please note paragraph "8." above and the preceding observations regarding surrendered subject matter.

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
 - a. U.S. Pat. No. 5,651,427 to Kulak.
 - b. U.S. Pat. No. 5,749,627 to Perego.
12. Submission of any response by facsimile transmission is encouraged. Group 3677's relevant facsimile numbers are :
 - 703-872-9326, for formal communications for entry **before Final** action: or

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- 703-872-9327, for formal communications for entry **after Final** action.

Recognizing the fact that reducing cycle time in the processing and examination of patent applications will effectively increase a patent's term, it is to your benefit to submit responses by facsimile transmission whenever permissible. Such submission will place the response directly within our examining group and will eliminate Post Office processing and delivery time and will bypass the PTO's mail room processing and delivery time. For a complete list of correspondence **not** permitted by facsimile transmission, see MPEP 502.01. In general, most responses and/or amendments not requiring a fee, as well as those requiring a fee but charging such fee to a Deposit Account, can be submitted by facsimile transmission. Responses requiring a fee which applicant is paying by check **should not be** submitted by facsimile transmission separately from the check.

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP 512). The following is an example of the format the certification might take:

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office (Fax No. (703) ____ - ____) on _____
(Date)

Typed or printed name of person signing this certificate:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up copy of the response after your response has been transmitted by facsimile will only cause further unnecessary delays in the processing of your application; duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.

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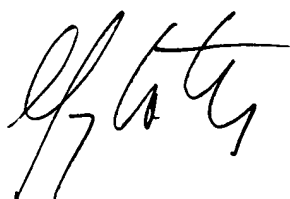
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Estremsky whose telephone number is (703) 308 - 0494. The examiner can normally be reached on M - Th from 730 am to 600 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann, can be reached on (703) 306-4115.

14. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-2168.

- Technology Center 3600 Customer Service is available at 703-308-1113.

- General Customer Service numbers are at 800-786-9199 or 703-308-9000.



GARY ESTREMSKY
PRIMARY EXAMINER

GWE

August 6, 2003